

ESTTA Tracking number: **ESTTA380686**

Filing date: **11/26/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

| | |
|------------------------|---|
| Proceeding | 92052557 |
| Party | Defendant Infragas North America Inc. |
| Correspondence Address | GENE S WINTER ST ONGE STEWARD JOHNSTON & REENS LLC 986 BEDFORD STREET STAMFORD, CT 06905 UNITED STATES tm-pto@ssjr.com |
| Submission | Answer |
| Filer's Name | Ellen Croft |
| Filer's e-mail | ellen@ellencroft.com |
| Signature | /Ellen Croft/ |
| Date | 11/26/2010 |
| Attachments | response to questions uspto.pdf (4 pages)(21446 bytes) exhibit 1.pdf (1 page)(8359 bytes) exhibit 1busplan.pdf (1 page)(154596 bytes) exhibit1executive summary.pdf (1 page)(77888 bytes) exhibit 2.pdf (1 page)(8354 bytes) Pilatecize !.pdf (2 pages)(78553 bytes) signed certificateelectronic.pdf (1 page)(23323 bytes) signed certificateelectronicfedex.pdf (1 page)(27227 bytes) fedex1.pdf (1 page)(59427 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Registration No. 2,865,297

Ellen Croft
570 Maple Ave.
Carpinteria, CA 93013
ellen@ellencroft.com

October 10, 2010

VIA FEDERAL EXPRESS
VIA EMAIL (fgtraub@duanemorris.com)

Felicia G. Traub
Duane Morris LLP
1540 Broadway
New York, NY 10036-4086

In response to cancellation No. 92052571.

**Re: Purchase of Pilatesizer mark and registration N0 2865397 DM Ref. #: N1569
00016**

Dear Ms. Traub,

Ellen Croft is representing herself in this matter. Please find responses to letter dated June 17, 2010 below.

Paragraph 1:

Regarding Ms. Borden "first use" of the mark "PILATECIZE".
Ms. Borden registered the mark "PILATECIZE" with the Canadian Trademark office in 2003. Ms. Borden has not provided any evidence that she had "first use" of the mark PILATECIZE prior to that date. Please provide proof of Ms. Borden's claim.

Ellen Croft's "first use" of "PILATESIZER" was in 1999 while residing in Crest Park, CA. In 1999 early 2000 the first prototypes for the Pilates based exercise machine the "PILATESIZER" were produced. During this time, Ms. Croft registered the name with an online website called "First Use". This web site is no longer in existence; however persons associated with Ms. Croft during this period will support her claim.

Prior to October 27, 2000, (which is the date that the “PILATESIZER” mark was issued.) Ms. Croft did extensive online searches to see if the mark was available and found no use of the name or mark listed with the USPTO or with any web sites anywhere, including several variations of the name. There was nothing listed on the web search engines that was even close to “PILATESIZE” or “PILATESIZER”. It was only after Ms. Croft’s extensive research that she decided to register the mark with the USPTO.

Ellen Croft’s use of the mark “PILATESIZER” precedes Haley Borden’s first use. Ms. Croft’s Trademark of “PILATESIZER” (2000) predates Ms. Borden’s mark in 2003.

Paragraph 2:

The registration of claim of first use in 2003 is incorrect. This is an error. I have attached Exhibit #1 as proof. Ms. Croft was actively seeking a marketing/licensing agreement from 2000-2003 and there were numerous contacts like Exhibit #1 that predate the 2003 claim. June 2003 Ms. Croft began negotiations toward a Guthy Renker manufacturing agreement of the PILATESIZER.

The mark “PILATESIZER” has continued to be used in connection with goods. The PILATESIZER is the name used to describe Ellen Croft’s patented Pilates exercise machine.

The claim that Ms. Croft discontinued use of the mark in 2006 is incorrect.

Please see list of events below. Documents supporting these dates and dates mentioned above exist and are in storage.

2003- Ms. Croft begins negotiations toward Guthy Renker licensing agreement. All parties agree to move forward in good faith and Ms. Croft ceases attempts to license to other companies.

2004- Licensing agreement is signed. Agreement stipulates that Ms. Croft cannot market or promote any other Pilates equipment under the value of \$650.00 and the agreement gives both the mark PILATESIZER as well as the machine to Guthy Renker with exclusive rights to manufacture and market. Agreement also stipulates the term of 2 years following 30 days after “roll out” of the infomercial.

Dec. 2005 Infomercial “rolls out” Ms. Croft is bound by the agreement and cannot use mark until January 2008.

January 2008 the contract is unwound. The mark and goods are returned to Ms. Croft. 2008 Ms. Croft begins and she has continued to actively seek business agreements with fitness equipment companies, marketing companies and manufacturers to produce the PILATESIZER.

Paragraph 3:

The mark “PILATESIZER” has never been abandoned. Adamant about supporting the

United States economy and manufacturing in the US, Ms. Croft has rejected any foreign manufacturing and been working to secure a US manufacturer. It has taken two years to convince US manufacturers to lower prices to a point where Ms. Croft can compete with foreign knockoffs of her own product. The US manufactured "PILATESIZER" machines will go into production on or before November 15, 2010 in Ventura, California. A press release will follow. Some parts have already been produced and Ms. Croft's new online store to sell Ellen Croft's PILATESIZER equipment and supplies will launch October 30th, 2010. This store will service the thousands of people worldwide who purchased Ellen Croft's Pilates machine. The timing of this cancellation has been unfortunate as Ms. Croft does not want to launch a marketing campaign utilizing her mark the "PILATESIZER" until this issue has been resolved.

Ellen Croft is not aware of any ill will to the brand. This remark is an attempt to slander Ms. Croft's reputation and we request written proof of such allegations.

Paragraph 4:

Exhibit B does not represent Ms. Borden's use of the mark "PILATECIZE". Please see Exhibit #2 taken from Ms. Borden's web site. Ms. Borden utilizes the mark PILATECIZE to trade mark fitness routines. Please explain how the routine itself is a service?

Paragraph 5:

No response necessary.

Paragraph 6:

The "PILATESIZER" trademark has never been abandoned. Dues to the USPTO have been paid and there has been constant forward progression with the launch of goods associated with the mark.

Paragraph 7:

No response necessary. See paragraph 3.

Paragraph 8:

No response at this time.

Paragraph 9:

Ms. Croft has no interest in selling her mark PILATESIZER to Ms. Borden as she believes it would damage the fitness community to encapsulate exercise routines. Trade marking a system of movement that is not completely original in every aspect would be damaging to the Fitness, Pilates, Yoga community. These practices have a finite amount of exercises and movement and the ability to trademark any sequence of these movements would lead to monopoly. The USPTO has been through similar territory with the Trademark PILATES.

Please clarify Ms. Borden's intentions with regards to what "services" she is trade marking.

Ms. Croft has maintained her focus to utilize the mark "PILATESIZER" in a broader capacity. As such it is attached to "real property".

Thank you for your consideration of Ms. Croft's response.

Sincerely,

Ellen Croft
ellen@ellencroft.com

Haley Borden d/b/a Pilatecize v. Ellen Croft d/b/a Pilatesize

Tabb cancellation No 92052571

Exhibit 1

**South Coast
Business Visions, Inc.**

July 29, 2000

Ellen Croft
P.O. Box 175
Crest Park, CA 92326
805-570-4014

Final Invoice

Total fee for Business Plan
Less: Initial payment received
Balance due

\$3,000
\$1,500
\$1,500

Total due this invoice with presentation of completed business plan

\$2,500

A disk with the narrative business plan has been provided to Client. Any subsequent bound copies in addition to the three included in this invoice will be provided at Client's expense, which will be the cost to South Coast Business Visions, Inc. to produce and deliver these.
South Coast Business Visions, Inc. realizes that the marketing strategy and financials may change as a result of input from the expanded management team. Upon written request, South Coast Business Visions, Inc. will incorporate new information submitted by Client into Business Plan one time at no additional charge for a period of 120 days from the date of this invoice.

1423 Shoreline Drive
Santa Barbara, CA 93109

Patricia Farmer 805.899.4210 pfarmer@scbv.com
Larry E. Phillips 805.966.2997 lphillips@scbv.com

CROFTCO EXECUTIVE SUMMARY

Business

Croftco is a Health, Fitness industry company. Offering fitness with a focus on overall mind/body health. No beefcake here! The mission of **Croftco** is to develop a fitness, health and well being empire within the next three years. Providing unique, high quality equipment, products, education, supplies and services at an affordable cost. Helping the masses heal themselves or simply stay fit.

Legal Structure

A California "C" Corporation.

Management

Ellen S. Croft, Founder of Croftco, and the inventor of the **Croftco Wall Unit, Trademarked the *Pilatesizer™*** has 20 years experience in the fitness industry with the last 10 years centered in the principles of Joseph H. Pilates. Ms. Croft's background includes working with a variety of amateur and professional athletes, including nationally ranked figure skaters, golfers and Olympians. Ms. Croft has worked numerous physicians and is sought out by professionals and corporations to assist with structural and functional mobility problems as well as neck and back pain. Competitive athletes and Fortune 500 executives have also sought out Ms. Croft.

Edward E. Lewis III-will be joining Croftco in the capacity of **Chief Operating Officer**. He brings with him 25 years in Program management, operations management, industrial management and most importantly new product development. He has successfully managed programs in excess of \$100,000,000 in both commercial and military environments. He has a B.S. in Industrial Engineering and an MBA.

Sheryl L. Illes-Brunk, CPA- Will be acting CFO during the start-up phase and will be used as an internal auditor as the corporation grows.

Products/Services Offered

Patents: The Pilatesizer™ US Patent No: 6,328,679

Trademark: Pilatesizer™

Domain Names: Croftco. Org, net, ws

Pilatesizer.Com, Org, Net, ws

The Pilatesizer™ Designed by aerospace engineers.

The ***Pilatesizer™*** will retail for \$520.00 and the unit sold through infomercials will retail for \$200.00. The manufacturer will provide a 10-year product warranty. The ***Pilatesizer™*** is a dynamic, affordable, lightweight, compact, piece of equipment that simulates the movements preformed on the Cadillac/Trapeze, Joseph Pilates' first piece of equipment. It is the only piece of equipment on the market designed with specific instructions for correcting postural misalignments while increasing core body strength, flexibility and mind body awareness.



Haley Borden d/b/a Pilatecize v. Ellen Croft d/b/a Pilatesize

Tabb cancellation No 92052571

Exhibit 2

Pilatecize!™

CUSTOMIZED FITNESS PROGRAMS

ABOUT PILATECIZE

HALEY'S PICTURES

VIEW EXERCISES

HALEY'S VIDEO

ABOUT HALEY

»Testimonials

ABOUT PILATECIZE™

Pilates - [pronounced (pi-lah-tees)] is the technique of properly aligning the body through controlled movements in order to develop strength and flexibility in the muscles, without building bulk. It has become a popular way to exercise and a part of mainstream fitness all over the world.

Pilatecize™ is a revolutionary, **all-in-one**, mind and body technique that combines the "core" principles of **Pilates** and **Yoga**, the balance and coordination of the **exercise ball** and **strength training** with the rubber band into one fun filled total body-conditioning program.

You will experience an incredible workout that will sculpture your entire body, establish core abdominal strength, improve your balance, coordination, flexibility, release stress, and will leave your body feeling relaxed and toned. This routine provides twice the workout in half the time.

Pilatecize™ will transform the way you look, feel, and perform.

The **Pilatecize™** routine is based on the Pilates program developed by Joseph Pilates during World War I. Pilates taught fellow prisoners to maintain their health through a series of exercises combining physical fitness with breath and mental activity. His program increased their strength and muscle flexibility without building bulk. Now, because it works, the Pilates program has become immensely popular. **Haley Borden** is a certified Pilates instructor, who has integrated the Pilates technique with the exercise ball, combining it with yoga and strength training with the rubber band to work the body more efficiently. This unique blend of body movements is a safe and effective exercise program using non-impact movement for restoring and maintaining good postural health. Every movement in each exercise is enhanced while adding intensity, stability and fun to the workout. Haley's positive visualization suggestions make it seem easy for the mind and the body to coordinate, stretch to new limits and move beyond.

Pilatecize™ combines the best of the best into one great workout!

Strong core abdominal muscles that are referred to, as your midsection or "powerhouse" will help keep you centered and properly aligned. This muscle control and postural awareness will help you throughout your everyday functional activities. Such as, how you sit at a compute, pick up your child, reach for the top shelf in your closet, or if you slip while walking, when you rely on your balance and coordination the most.

Breathing patterns are used to help the body relax and focus on "centering" which will connect your mind to the muscles you are using. By increasing your powerhouse you will not only stand taller and look leaner, it will help relieve your lower back pain, which is contributed from weak abdominal muscles.

The exercise ball helps develop core strength along with balance and coordination. Just sitting on the ball will improve your posture - you can't slouch on the ball like in chair and bouncing on the ball is fun - you feel like a child again. The exercise ball is widely used by physiotherapist in rehabilitation programs.

The major league baseball team the **Toronto Blue Jays** has implemented the Pilatecize™ program into the ball players training routine for a challenge of athletic ability in strengthening the ball player's core which will help reduce sports injuries. The demand and discipline of a baseball player is to be on the field and in the game injury free and pain free. When you are injured the other muscles come into play to alleviate the pressure on the injured area this will lead to an imbalance of your musculoskeletal structures. Realignment of the body requires re-educating the musculature structure to the new movement. Stretching and lengthening the tight muscles and strengthening the core abdominals will achieve greater range of motion and increased flexibility, making it easier for the professional ball player to slide into home plate!

Here are just a few things this innovative total body workout does:

- **Pilatecize™ sculpts the entire body.**
By adding the exercise ball and band to the routine, Haley has ensured that each part of the routine works the full body - the upper, the lower body and the core muscles. A toned body is more graceful, better coordinated and healthier.
- **Pilatecize™ establishes abdominal core strength.**
Pilatecize™ improves the "core" abdominal muscles, also referred to as the center or midsection. This not only helps one to stand taller and look leaner but relieves lower back pain as well. This muscle control and postural awareness helps you throughout the day, whether one is sitting at a computer, picking up a child, reaching for the top shelf, or regaining your balance after a slip.
- **Pilatecize™ improves posture, balance, coordination, and flexibility.**
Stronger core muscles lead to better posture. Simply sitting on the exercise ball engages the core muscles, which improves balance and coordination. This will make you feel taller!
- **Pilatecize™ relieves stress.**
The Pilatecize™ breathing patterns help the body relax. The Pilatecize™ routine incorporates the breathing techniques of Pilates and yoga to encourage relaxation, heighten focus and oxygenate the blood.
- **Pilatecize™ leaves the body feeling toned and relaxed**
The constant attention to breathing and the addition of visualization techniques help to strengthen and relax the muscles. Pilatecize™ is the perfect way to combat the stresses of everyday life.
- **Pilatecize™ safe.**
Since the Pilatecize™ technique uses non-impact movements; it is a safe and effective exercise program that is fun for all fitness levels and ages. It causes no wear and tear on joints. Instead it can restore and maintain good postural health.

Contact Pilatecize at haley@pilatecize.com




Pilatecize!™

All material copyright Haley Borden Enterprises Ltd.

This material, including photographs may not be copied or used in any forms without permission form Haley Borden Enterprises Ltd.

CERTIFICATE OF ELECTRONIC FILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING ADDRESSED TO: COMMISSIONER FOR TRADEMARKS, P.O. BOX 1451, ALEXANDRIA, VIRGINIA 22313-1451, AND THAT THIS CORRESPONDENCE IS BEING DEPOSITED VIA THE ELECTRONIC SYSTEM FOR TRADEMARK TRIALS AND APPEALS (ESSTA) ON THE DATE INDICATED BELOW.

By: 

Date: 11-26-2010

CERTIFICATE OF SERVICE UNDER 37 C.F.R. §2.119(a)

I hereby certify that on November 26th, 2010, the following document was deposited with Federal Express, with sufficient postage as first class mail in envelopes addressed to Hale C. Bordens Correspondent of Record: Federal Express tracking #8634 9266 6167

| |
|---|
| To Correspondent of Record: |
| FELICIA G. TRAUB |
| DUANE MORRIS LLP |
| 1540 BROADWAY |
| NEW YORK, NY 10036 |
| frtraub@duanemorris.com,ccampbell@duanemorris.com |

By  

FedEx Express

FedEx Tracking Number

8634 9266 6167

Sender's Copy

1 From Please print and press hard.

Date _____ Sender's FedEx Account Number _____ SENDER'S FEDEX ACCOUNT NUMBER ONLY

Sender's Name Ellen Croft Phone (805) 636-9466

Company _____

Address 570 MAPLE AVE.

City CARPINTERIA State CA ZIP 93013

2 Your Internal Billing Reference

First 24 characters will appear on invoice.

OPTIONAL

3 To

Recipient's Name FELICIA G. TRAVIS Phone () _____

Company DWANE MORRIS LLP

Recipient's Address 1540 BROADWAY

We cannot deliver to P.O. boxes or P.O. ZIP codes.

Dept./Floor/Suite/Room _____

Address _____

To request a package be held at a specific FedEx location, print FedEx address here.

City New York State NY ZIP 10036

4a Express Package Service

- ☐ FedEx Priority Overnight
Next business morning.* Friday shipments will be delivered on Monday unless SATURDAY Delivery is selected.
- ☒ FedEx Standard Overnight
Next business afternoon.* Saturday Delivery NOT available.
- ☐ FedEx 2Day
Second business day.* Thursday shipments will be delivered on Monday unless SATURDAY Delivery is selected.
- ☐ FedEx Express Saver
Third business day.* Saturday Delivery NOT available.

FedEx Envelope rate not available. Minimum charge: One-pound rate.

Packages up to 150 lbs.

☐ FedEx First Overnight
Earliest next business morning delivery to select locations.* Saturday Delivery NOT available.

4b Express Freight Service

- ☐ FedEx 1Day Freight*
Next business day.** Friday shipments will be delivered on Monday unless SATURDAY Delivery is selected.
- ☐ FedEx 2Day Freight
Second business day.* Thursday shipments will be delivered on Monday unless SATURDAY Delivery is selected.

Packages over 150 lbs.

☐ FedEx 3Day Freight
Third business day.** Saturday Delivery NOT available.

* Call for Confirmation.

** To meet locations.

5 Packaging

- ☒ FedEx Envelope* ☐ FedEx Pak* Includes FedEx Small Pak, FedEx Large Pak, and FedEx Sturdy Pak. ☐ FedEx Box ☐ FedEx Tube ☐ Other

* Declared value limit \$500.

6 Special Handling

- ☐ SATURDAY Delivery
NOT Available for FedEx Standard Overnight, FedEx First Overnight, FedEx Express Saver, or FedEx 2Day Freight.
- ☐ HOLD Weekday at FedEx Location
NOT Available for FedEx First Overnight.
- ☐ HOLD Saturday at FedEx Location
Available ONLY for FedEx Priority Overnight and FedEx 2Day to select locations.

Does this shipment contain dangerous goods?

- ☐ No ☐ Yes (One box must be checked)
As per attached Shipper's Declaration. ☐ Yes Shipper's Declaration not required. ☐ Dry Ice Dry Ice, 4 UN 1845 x _____

Dangerous goods (including dry ice) cannot be shipped in FedEx packaging.

☐ Cargo Aircraft Only

7 Payment SHI to:

Enter FedEx Acct. No. or Credit Card No. below.

- ☒ Sender Acct. No. in Section 1 will be billed. ☐ Recipient ☐ Third Party ☐ Credit Card ☐ Cash/Check

FedEx Acct. No. _____
Credit Card No. _____

Exp. Date _____

Total Packages _____ Total Weight _____ Total Declared Value* \$.00

*Our liability is limited to \$100 unless you declare a higher value. See back for details. By using this Airbill you agree to the service conditions on the back of this Airbill and in the current FedEx Service Guide, including terms that limit our liability.

8 Residential Delivery Signature Options

If you require a signature, check Direct or Indirect.

- ☐ No Signature Required
Package may be left without obtaining a signature for delivery.
- ☒ Direct Signature
Someone at recipient's address may sign for delivery. Fee applies.
- ☐ Indirect Signature
If no one is available at recipient's address, someone at a neighboring address may sign for delivery. Fee applies.

520

Rev. Date 10/08 Part #198281-01 884-2008 FedEx PRINTED IN U.S.A. SRY

RETAIN THIS COPY FOR YOUR RECORDS.

fedex.com 1.800.GoFedEx 1.800.463.3339

